

Remarks

I. Introduction

This amendment is being submitted with a Request for Continued Examination (RCE) in response to the final Office Action mailed August 4, 2003. A response to the Office Action is due November 4, 2003. Accordingly, this amendment and the enclosed RCE are being timely filed.

Claims 1-47 were pending. By way of this response, claims 1, 25, and 32 have been amended. Support for the amendments to the specification and the claims can be found in the application as originally filed, and no new matter has been added. Accordingly, claims 1-47 remain pending.

Applicant acknowledges that the response filed May 15, 2003 was sufficient to overcome the claim objections and the previous rejections under 35 U.S.C. § 112. The only outstanding rejections of the claims are under 35 U.S.C. §§ 102 and 103.

In addition, claims 19-24 and 41-44 have been allowed.

II. Claim Rejections

A. Rejections Under 35 U.S.C. § 102

Claims 1-2, 4-5, 7, 9-11, 13-14, 17, 25-26, 29-33, 35-36, 39-40, and 45-46 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Conrad (U.S. Patent No. 3,431,046).

Claims 1, 25, and 32 have been amended as set forth above. The amendments to claims 1, 25, and 32 similarly apply to the claims dependent therefrom. Applicant respectfully traverses the rejections as they relate to the amended claims.

Similar to the German reference, DE 2546692, discussed in applicant's previous response, Conrad discloses a contact lens having a planar, or non-curved, peripheral portion on the posterior face of the contact lens. As stated at column 3, lines 50-54, and in reference to FIG. 3,

At circle 16 a planar surface of revolution 18 which is tangential to the spherical shape of the surface 14 is extended up to the periphery 20 of the contact lens so that the surface 18 is slightly raised from the eye. (emphasis added)

The planar surface of revolution 18 is clearly shown in FIG. 4. Thus, the ducts 22 do not extend into the curved portion of the lens. In fact, as shown in FIG. 4, the ducts 22 terminate at the junction of the planar surface 18 and the concave rear surface 14.

In contrast to the lenses of Conrad, the claimed lenses of claims 1, 25, and 32 include microchannels that extend through at least a substantial portion of the curved peripheral zone of the contact lenses. In other words, the microchannels (i) extend into the curved peripheral zone and terminate in the peripheral zone, (ii) extend to the border of the peripheral zone and the optical zone, and/or (iii) extend into the optical

zone. Thus, Conrad does not disclose, teach or even suggest the presently claimed lenses.

In view of the above, applicant submits that the present claims, and claims 1-2, 4-5, 7, 9-11, 13-14, 17, 25-26, 29-33, 35-36, 39-40, and 45-46 in particular, are not anticipated by Conrad under 35 U.S.C. § 102(b).

B. Rejections Under 35 U.S.C. § 103

Claims 1-14, 17-18, 25-27, 29-40, and 45-46 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Volk (U.S. Patent No. 5,347,326). Claims 3, 27-28, and 37 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Conrad in view of Haralambopoulos et al. (U.S. Patent No. 5,598,233). Claims 6, 12, and 38 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Conrad.

As indicated above, claims 1, 25, and 32 have been amended as set forth above. The amendments to claims 1, 25, and 32 similarly apply to the claims dependent therefrom. Applicant respectfully traverses the rejections as they apply to the amended claims.

Regarding the rejections of the claims over Volk, the Examiner believes that Volk's statement that the anterior surface can be a spherical surface would inherently accommodate movement of an eyelid over its face. In addition, the Examiner states that it would have been obvious to a person of ordinary skill in the art to have the anterior face configured to

accommodate movement of an eyelid over it since Volk teaches that the anterior face can be of any configuration depending upon its therapeutic use.

Claims 1, 25, and 32 indicate that the anterior face of the contact lens is configured to accommodate movement of an eyelid over the entire anterior face. Applicant respectfully disagrees that Volk expressly or inherently discloses such accommodation, and applicant submits that Volk does not suggest or provide a motivation to configure the anterior face to accommodate movement of an eyelid over the entire anterior face.

As the Examiner is aware, a reference must be interpreted as a whole, and cannot be picked apart to deprecate an invention (*In re Fine*, 837 F.2d 1071, 1075, (Fed. Cir. 1988)). As indicated previously, although Volk does disclose different anterior surface configurations, when read as a whole, Volk requires that the lens maintain an eyelid in an open configuration. In particular, at column 12, lines 27-31, Volk states

As a diagnostic or therapeutic contact lens is designed to maintain the eyelids of the patient open, the thickness of the lens is significantly greater than conventionally utilized with vision-correcting prescription contact lenses.

Thus, Volk clearly states that both diagnostic and therapeutic contact lenses disclosed in the patent are configured to maintain the eyelids in an open state. Therefore, applicant submits that a person of ordinary skill in the art would not be motivated to modify or configure the anterior

surface of the Volk lenses to accommodate eyelid movement thereover. Indeed, applicant submits that Volk actually teaches away from the lenses recited in the present claims, which are configured to accommodate movement of an eyelid over the entire anterior face. "As a general rule, references that teach away cannot serve to create a prima facie case of obviousness." (*McGinley v. Franklin Sports, Inc.* CAFC 8/21/01 citing *In re Gurley*, 31 USPQ2d 1131, (Fed. Cir. 1994)).

In view of the above, applicant submits that the present claims, and claims 1-14, 17-18, 25-27, 29-40, and 45-46 in particular, are unobvious from and patentable over Volk under 35 U.S.C. § 103.

Regarding the rejections of the claim over the combination of Conrad in view of Haralambopoulos, applicant respectfully submits that the combination of references fails to suggest all of the limitations recited in the present claims.

First, the primary reference, Conrad, fails to teach, disclose, or even suggest contact lenses having a curved peripheral portion located on the posterior face and a plurality of microchannels extending through a substantial portion of the curved peripheral portion, as discussed above. The secondary reference, Haralambopoulos, similarly fails to teach, disclose, or even suggest contact lenses with microchannels having a depth less than about 90% of the thickness of the lens. As indicated previously, Haralambopoulos discloses contact lenses with slits 12 extending through both the anterior and posterior surfaces of the contact lenses. As discussed at column 4, lines 23-32, the "slit channels" are fluid passages extending through both walls

of the lens and forming a passage between the anterior and posterior surfaces of the lens.

Applicant submits that one of ordinary skill in the art would not be motivated to combine Haralambopoulos with Conrad because the channels disclosed by Conrad are different and distinct from the slits disclosed by Haralambopoulos. Conrad discloses channels that attempt to direct fluid toward the perimeter of the lens, whereas the slits of Haralambopoulos are configured to pass fluid through the lens from the posterior surface to the anterior surface. In addition, even if the references could be combined, the combination fails to teach, disclose, or even suggest all of the limitations recited in the present claims, as discussed above.

In view of the above, applicant submits that the present claims, and claims 3, 27-28, and 37 are unobvious from and patentable over the combination of Conrad in view of Haralambopoulos under 35 U.S.C. § 103.

Regarding the rejection of claims 6, 12, and 38 over Conrad, applicant respectfully traverses the rejections. The number and dimensions of the microchannels recited in the present claims may provide enhancements to tear exchange when the contact lenses are worn on an eye. Applicant submits that Conrad does not teach, disclose, or even suggest the specified numbers and dimensions to render the claims obvious under 35 U.S.C. § 103. In addition, even if one of ordinary skill in the art would be motivated as suggested by the Examiner, Conrad still fails to teach, disclose, or even suggest all of the limitations recited in the claims, such as contact lenses with a

curved peripheral portion of the posterior face, and channels extending into the curved peripheral portion.

In view of the above, applicant submits that the present claims, and claims 6, 12, and 38 in particular, are unobvious from and patentable over Conrad under 35 U.S.C. § 103.

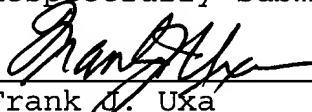
Each of the present dependent claims is separately patentable over the prior art. For example, none of the prior art disclose, teach, or even suggest the present contact lenses including the additional feature or features recited in any of the present dependent claims. Therefore, applicant submits that each of the present claims is separately patentable over the prior art.

III. Conclusion

In conclusion, applicant has shown that the present claims are not anticipated by and are unobvious from and patentable over the prior art under 35 U.S.C. §§ 102 and 103. Therefore, applicant submits that the present claims, that is claims 1-47 are allowable. Therefore, applicant requests the Examiner to pass the above-identified application to issuance at an early date. Should any matters remain unresolved, the Examiner is requested to call (collect) applicant's attorney at the telephone number given below.

Date: NOVEMBER 4, 2003

Respectfully submitted,



Frank J. Uxa
Attorney for Applicant
Registration No. 25,612
4 Venture, Suite 300
Irvine, California 92618
(949) 450-1750
(949) 450-1764 Facsimile